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U.S.S.N. 10/824,719

Schubert, et al.

METHOD AND APPARATUS FOR THE STORAGE  
AND RETRIEVAL OF HYDROGEN FOR USE WITH  
A HYDROGEN-BASED FUEL CELL

14 April 2004

Art Unit: 1745

Examiner: Melissa Thompson

Atty. Docket: DP-309743

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date given below.

March 8, 2007  
DateKandace Brown  
Kandace BrownRESTRICTION/ELECTION RESPONSECommissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir :

This is Applicants' response to the Office Action mailed February 8, 2007 requiring restriction of the above-identified application between claims 1-24 (group I) drawn to a system for storing and retrieving elemental hydrogen, claims 25-27 (group II) drawn to an auxiliary power system comprising a fuel cell combined with the system of group I), claims 28-30 (group III) drawn to a vehicle comprising the APU of group II, and claims 31-37 (group IV) drawn to a method for extruding silicon rods. Applicants provisionally elect claims 1-24 (group I), acquiesce to the requirement for restriction between the claims of group IV and

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U.S.S.N. 10/824,719 (DP-309743) - 2

the claims of groups I-III, and respectfully traverse the requirement for restriction between the claims of groups I, II, and III.

The Office Action correctly characterizes the claims of groups I, II, and III as being related as subcombination/combination, which requires that distinctness is shown if the combination does not require the particulars of the subcombination for patentability and if the subcombination has separate utility. Applicants respectfully submits that, in the present case, the combination claims do require the particulars of the subcombination claims for patentability. In each subcombination/combination relationship, the analysis asserted in the Office Action points to dependent claims in the subcombination that are not correspondingly found in the dependent claims of the combination, and concludes that the combination does not require the particulars of the subcombination for patentability. Applicants respectfully submit that this is an improper analysis.

Applicants submit that the proper analysis to use for the patentability determination in a subcombination/combination restriction requirement is to look at the combination claims and ask whether they would be patentable if the limitations in those combination claims that derive from the subcombination were removed. In the present case, if one were to remove the subcombination hydrogen storage elements from either of the combination APU or vehicle combination claims, one would be left with a generic APU or vehicle that is already known in the art. Therefore, Applicants respectfully submit that the combination claims clearly do require the particulars of the subcombination for patentability.

Under the analysis used in the Office Action, unless each combination claim were to contain each and every limitation of *all* of the subcombination dependent claims (resulting in ridiculously long combination claims), one could

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MAR 08 2007

U.S.S.N. 10/824,719 (DP-309743) - 3

never overcome a subcombination/combination restriction requirement because there would always be *some* limitation somewhere in the subcombination claims that would not be present in at least one of the combination claims. Using Applicants' proposed reasonable analysis, on the other hand, would not place any additional burden on the Patent Office as only the hydrogen storage feature needs to be searched because the combination claims depend on the hydrogen storage feature for patentability. If examination results in amendments to narrow the scope of the hydrogen storage features of the broadest subcombination claims, those amendments would also have to be carried through into the combination claims.

For the above reasons, Applicants respectfully submit that the requirement for restriction between the claims of groups I, II, and III should be withdrawn. If there are any additional charges with respect to this Response or otherwise, please charge them to Deposit Account No. 50-0831 maintained by Applicants' attorney.

Respectfully submitted,

  
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